



UNITED STATES PATENT AND TRADEMARK OFFICE

UNITED STATES DEPARTMENT OF COMMERCE
United States Patent and Trademark Office
Address: COMMISSIONER FOR PATENTS
P.O. Box 1450
Alexandria, Virginia 22313-1450
www.uspto.gov

APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
-----------------	-------------	----------------------	---------------------	------------------

09/918,501

08/01/2001

Hubert Helaine

Q65593

3234

23373

7590

03/09/2006

SUGHRUE MION, PLLC
2100 PENNSYLVANIA AVENUE, N.W.
SUITE 800
WASHINGTON, DC 20037

EXAMINER

TORRES, MARCOS L

ART UNIT

PAPER NUMBER

2687

DATE MAILED: 03/09/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

Office Action Summary

Application No.

09/918,501

Applicant(s)

HELAINE ET AL.

Examiner

Marcos L. Torres

Art Unit

2687

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 22 December 2005.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-16 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-16 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Response to Arguments

1. Applicant's arguments filed 12-22-2005 have been fully considered but they are not persuasive.
2. Regarding applicant arguments about the combination of the references, in addition to the motivation already presented, Shah is directed to offering features to mobile station using different provider/network (see col. 1, lines 5-10); Khan is directed to offering intelligent features to mobile station (see col. 1, line 65 – col. 2, line 1). Since both references are directed to offer features to the mobile station, it would have been obvious to one of the ordinary skill in the art at the time of invention to combine the Shah and Khan teachings to extend the features coverage.
3. Regarding applicant arguments that Khan teaches away; the portion submitted by the applicant is misplaced because is referring to the description of prior art without considering Khan's improvements, in col.1, lines 48-52 Khan discloses multiple mobile station registering to use the private base station. The rejection in record stands.

Claim Rejections - 35 USC § 103

4. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

5. The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

6. Claims 1-2, 9 and 12-16 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah US 6,029,065 in view of Khan US 5,745,852.

As to claims 1, 15 and 16, Shah discloses an automatic network services management method (see col. 1, lines 5-10) comprising: connecting a communication terminal of a first network is connected to a base (see col. 2, lines 9-17), connecting said private base is connected to a second network (see col. 2, lines 17-21), and a correspondence memory establishing a correspondence between service codes of said first network and service codes of said second network (see col. 3, lines 35-40). In an analogous art, Khan discloses connecting a communication terminal of a first network is connected to a private base (see fig. 1, items 14, 20), thereby enabling the connection of a network with a private base. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of invention to combine the Shah and Khan teachings for the simple purpose of permitting the user to take advantage of the reduced call cost in the private base.

As to claim 2, Shah discloses the method of using a correspondence memory in the communication terminal (see col. 4, lines 1-9)

As to claim 9, Shah discloses the method wherein said correspondence memory is updated between a call of between the terminal and the first network (see col. 10, lines 31-35).

As to claims 12 and 13, Shah discloses the method wherein said first network is a mobile telephone network and second network is a terrestrial telephone network (see col. 1, lines 14-17).

As to claim 14, Shah discloses the method wherein said mobile communication terminal is automatically connected to said private base when said terminal is within range of said base (see col. 6, lines 40-44).

7. Claim 3 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shah in view of Khan and further in view of Sipilä (EP 0748136A1).

As to claim 3, Shah discloses everything claimed as explained above (see claim 1) except for the method wherein said correspondence memory is in said private base. In an analogous art, Sipilä discloses the method wherein said correspondence memory is in said private base (see col. 2, lines 3-11; col. 9, lines 27-52), therefore allowing the updated features be used in legacy terminal. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique for the simple purpose of compatibility with old terminals.

8. Claims 4 and 6-7 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah in view of Khan and Sipilä as applied to claim 3 above, and further in view of Kasmperschroer (U.S. Patent US006434399B1).

As to claim 4, Shah the method wherein: a request corresponding to a service is composed from said communication terminal (see col. 9, lines 1-3), said request is sent from said communication terminal and received at said private base (see col. 9, lines 13-15). Shah does not specifically disclose said request is sent to said second network and is received by an operator managing said services of said second network, or wherein said request is updated in said private base as a function of said correspondence memory. Sipilä discloses wherein said request is updated in said private base as a function of said correspondence memory (see col. 9, line 26 - col. 10, line 3). Sipilä does not specifically disclose said request is sent to said second network and is received by an operator managing said services of said second network. Kasmperschroer disclose said request is sent to said second network and is received by an operator managing said services of said second network (see col. 7, lines 6-24). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this teaching to the Sipilä method to ensure compatibility in the connection.

As to claims 6 and 7, Kasmperschroer disclose processing of said request by an operator managing said services of said second network (see col. 7, lines 6-24). Shah discloses the method wherein an acknowledgement is received at said communication terminal or private base (see col. 11, lines 13-22). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use this technique for the simple purpose of confirms the delivery of data.

9. Claim 5 is rejected under 35 U.S.C. 103(a) as being unpatentable over Shah in view of Khan and Sipilä and further in view of Kasmperschroer as applied to claims 4 and 6-7 above, and further in view of Vanden Heuvel (U.S. Patent US005924014A).

As to claim 5, Sipilä discloses the method wherein, if said correspondence data contains no match to said request sent by said communication terminal send an error message (see col. 9, lines 13-17). Kasmperschroer disclose said request is sent to said second network and is received by an operator managing said services of said second network (see col. 7, lines 6-24). Sipilä and Kasmperschroer do not specifically disclose transmitting without changing the format. Vanden Heuvel discloses transmitting without changing the format (see col. 10, lines 16-21). Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to add this technique to the modified Sipilä and Kasmperschroer method for the simple purpose of compatibility.

10. Claims 8-11 are rejected under 35 U.S.C. 103(a) as being unpatentable over Shah in view of Khan and Kasmperschroer.

As to claim 8, Shah discloses everything claimed as explained above (see claim 1) except for the method wherein said correspondence memory is updated during a call between said private base and an operator. In an analogous art, Kasmperschroer the method wherein said correspondence memory is updated during a call between said private base and an operator (see col. 7, lines 6-24)., thereby allowing to updated the services between the system. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to combine both teachings for enhanced compatibility between systems.

As to claims 9, Shah discloses the method wherein said correspondence memory is updated automatically (see col. 6, lines 40-45).

As to claim 11, Shah discloses the method wherein said updating is triggered by a user (see col. 10, lines 46-48).

As to claim 10, Shah discloses the method wherein said correspondence memory is updated periodically. However, OFFICIAL NOTICE IS TAKEN THAT the technique of updating memory periodically it is a common and well-known technique. Therefore, it would have been obvious to one of the ordinary skill in the art at the time of the invention to use this technique for the simple reason of refresh the memory cycle and preserve the data.

Conclusion

11. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any response to this Office Action should be mailed to:

U.S. Patent and Trademark Office
Commissioner of Patents
P.O. Box 1450
Alexandria, VA 22313-1450

Or faxed to:

571-273-8300

for formal communication intended for entry, informal communication or draft communication; in the case of informal or draft communication, please label "PROPOSED" or "DRAFT"

Hand delivered responses should be brought to:

Customer Service Window
Randolph Building
401 Dulany Street
Alexandria, VA 22314

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Marcos L. Torres whose telephone number is 571-272-7926. The examiner can normally be reached on 8:00am-6:00 PM alt. Wednesday Off.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, George Eng can be reached on 571-252-7495. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

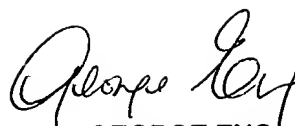
Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Application/Control Number: 09/918,501
Art Unit: 2687

Page 9

Marcos L Torres
Examiner
Art Unit 2687


mlt


GEORGE ENG
SUPERVISORY PATENT EXAMINER